

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated February 9, 2004, indicated that claims 1, 4, and 16-25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Kubler et al.* (US 5,726,984). Claims 2, 3, 5, 6, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kubler et al.* (US 5,726,984) in view of *Kuthyar et al.* (US 5,909,431), *Shinohara et al.* (US 5,351,237). Claims 7 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kubler et al.* (US 5,726,984) in view of *Schulzrinne et al.* (RFC 1889). Claims 8, 9, and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kubler et al.* (US 5,726,984) in view of *Kuthyar et al.* (US 5,909,431), and *Shinohara et al.* (US 5,351,237) as applied to claims 1, 4, and 5 above, and further in view of *Schulzrinne et al.* (RFC 1889).

Applicant respectfully traverses the Section 102(e) rejection of claims 1, 4 and 16-25 because the cited '984 reference does not provide adequate correspondence to the claimed limitations in the instant invention. For example, the processing circuit 5609 does not, as the Examiner asserts, analyze audio information that designates a telephonic communication addressee and determine whether the audio information is to be coupled to a standard switched telephone network or a Internet communications network. Rather, the processing circuit 5609 receives a phone number and sends the number to a host device (computer 5515 of FIG. 55a). *See, e.g.*, column 87, line 65 through column 88, line 5 of the '984 reference. The host device then compares the received telephone number to a database and directs the routing of the telephone call using the processing circuit 5609. *See, e.g.*, column 88, lines 6-64. In this regard, the processing circuit 5609 does not analyze or designate as asserted in the Office Action, and is limited in function to processing at the control of an external host device.

In addition, it appears that a user must designate the approach for routing the call at the host device using stored information, such that the processing circuit 5609 cannot automatically determine call routing characteristics based on designated telephonic communication addressee information. *See, e.g.*, column 88, lines 6-17. Thus, the processing circuit 5609 (and the computer card 5601) cannot, as the Examiner asserts,

determine whether audio information is to be coupled to a standard telephone network or an Internet communication network. In this regard, the '984 reference fails to teach all of the claimed limitations. For instance, relative to the limitations in claim 17 of the instant invention, the interface unit automatically determines whether the audio information is to be coupled to standard or Internet-based networks. The cited portions of the '984 reference teach away from such automatic determination, and are apparently limited to using predefined data for determining call routing, as discussed above.

Applicant further traverses the Section 103(a) rejections, all of which rely upon the '984 reference as a primary reference, because the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, as indicated in the M.P.E.P, the prior art reference (or references when combined) must teach or suggest all of the claim limitations, and there must be some suggestion or motivation to modify the reference or to combine reference teachings. In this instance, the Examiner failed to show correspondence between the cited references and all of the claimed limitations, and further failed to cite evidence of motivation for modifying the primary '984 reference.

In view of the above discussion regarding the failure of the '984 reference to teach various claimed limitations, Applicant submits that the Section 103(a) rejections, all of which rely upon similar teachings in the '984 reference, also fail to provide correspondence to all of the claimed limitations. Therefore, the Section 103(a) rejections are also improper and should be removed.

Notwithstanding the above traversals, Applicant has amended each of the independent claims. These amendments include subject matter directed to managing telephony communications as a function of Internet connectivity of a designated party. For instance, where a user wishes to make a call to a particular party, the Internet protocol connectivity status of that party can be ascertained to determine whether the party can receive an Internet protocol telephone call. This connectivity status may be determined by, for example, actively checking (via the Internet) the current online status. If the party is off line, the telephone call can be connected using a standard switched telephone network. If the party is online, the call can be connected using an Internet protocol telephone network. Support for these amendments, as well as the new dependent claims, can be found, for example, in the Specification at page 6, lines 4-22.

The new claims are directed to subject matter that should be allowable over the cited references. For example, the subject matter to which the new claims are directed includes the use of active Internet protocol status. In some instances, the claimed subject matter is further directed to analyzing audio information as a function of Internet protocol connectivity status of a telephonic communications addressee. As discussed above, none of the cited references teaches or suggest such limitations. In addition, other claimed subject matter is directed to establish internet telephonic communications as a function of a calling party's telephone number. Applicant submits that the cited portions of the references do not teach or suggest these limitations.

Please charge Deposit Account number 50-0996 (8X8S.004PA) in the amount of \$406 for new claims 26-38.

In view of the above discussion, Applicant believes that the rejections have been overcome and the application is in condition for allowance. A favorable response is requested.

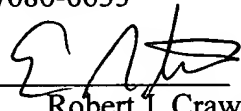
Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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